

REMARKS

This paper is presented in response to the Office Action. Claims 19-36 have been withdrawn by the Examiner as being directed to an unelected species/invention. Claims 1-18 remain pending.

Reconsideration of the application is respectfully requested in view of the aforementioned amendments and the following remarks. For the convenience and reference of the Examiner, the remarks of the Applicant are presented in the order in which the corresponding issues were raised in the Office Action.

I. General Considerations

Applicant notes that the remarks, or a lack of remarks, presented herein are not intended to constitute, and should not be construed as, an acquiescence, on the part of the Applicant: as to the purported teachings or prior art status of the cited references; as to the characterization of the cited references advanced by the Examiner; or as to any other assertions, allegations or characterizations made by the Examiner at any time in this case. Applicant reserves the right to challenge the purported teaching and prior art status of the cited references at any appropriate time.

II. Rejection of Claims 1 and 5-11 under 35 U.S.C. § 102

Applicant respectfully notes that a claim is anticipated under 35 U.S.C. § 102(a), (b), or (e) only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. Further, the identical invention must be shown in as complete detail as is contained in the claim. Finally, the elements must be arranged as required by the claim. *MPEP* § 2131.

The Examiner has rejected claims 1 and 5-11 under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,473,457 to Ono (“*Ono*”). Applicant respectfully disagrees.

In the rejection of claims 1 and 8, from which claims 5-7 and 9-11 depend, the Examiner has generally alleged that *Ono* discloses “a system for adjusting losses based upon polarization, the system comprising: a first optical device 1 having an optical output; a second optical device 11 optically coupled to the first optical device; and a polarization controller 9 optically coupled to both said first optical device and said second optical device, said polarization controller minimizing loss by adjusting a polarization state of said optical output of said first optical device to reduce a total polarization-dependent loss of said first and second optical devices,” referring to “ABS; Figs. 1 and 3; column 3, line 31 through column 7, line 14.” *Emphasis added.* However, a review of *Ono* reveals that the single reference made by the Examiner embraces almost the entire specification of *Ono*.

As the foregoing makes clear, the Examiner has specifically identified only three elements of *Ono* that the Examiner believes correspond to elements recited in the rejected claims, namely, a “first optical device 1,” a “second optical device 11,” and a “polarization controller 9.” As to the remaining elements recited in the rejected claim, the Examiner has provided only a vague assertion that those elements are disclosed in *Ono*.

With particular reference to claims 1 and 8, Applicant respectfully submits that the Examiner has failed to identify, with any specificity whatsoever, which element(s) of *Ono* is/are purported to correspond to, for example, the elements “an optical output,” “a polarization state,” and “a total polarization-dependent loss” recited in claim 1.

Regarding claims 5 and 9, Applicant further respectfully submits that the Examiner has also failed to specifically identify, for example, which element(s) of *Ono* is/are purported to correspond to the “output of said second optical device,” recited in claims 5 and 9.

As a result of the vague, non-specific rejection stated by the Examiner, Applicant is left to guess at the position of the Examiner concerning which particular elements of the cited reference are purported to correspond to the claimed elements. This much Applicant respectfully declines to do, at least because the Examiner bears the burden of establishing anticipation.

In view of the foregoing, Applicant respectfully submits that the Examiner has failed to establish that *Ono* anticipates claims 1 and 5-11, at least because the Examiner has not established that each and every element as set forth in the rejected claims is found in *Ono*, and because the Examiner has not established that the identical invention is shown in *Ono* in as complete detail as is contained in the rejected claims. Applicant thus respectfully submits that the rejection of claims 1 and 5-11 should be withdrawn.

III. Rejection of Claims 2, 3, 12-14, and 16-18 under 35 U.S.C. § 103

Applicant respectfully notes at the outset that in order to establish a *prima facie* case of obviousness, it is the burden of the Examiner to demonstrate that three criteria are met: first, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings; second, there must be a reasonable expectation of success; and third, the prior art reference (or references when combined) must teach or suggest all the claim limitations. *MPEP* § 2143.

The Examiner has rejected claims 2, 3, 12-14, and 16-18 under 35 U.S.C. § 103(a) as being obvious over *Ono*. For at least the reasons set forth herein, Applicant respectfully disagrees.

After making the same general allegation and reference to *Ono* noted at II. above, the Examiner then concedes that *Ono* “does not explicitly teach that the controller comprises at least one fiber optic

cable loop contained in a 'petal'." However, the Examiner goes on to allege that *Ono* teaches "optical fiber loops (8 and 10)" and that "adding a protective jacket or sheath to the fiber (and containing it within a petal) would have been obvious ... since protecting an optical fiber would inherently improve its optical coupling and decrease error/loss."

Regarding claims 2, 3, and 12, Applicant respectfully submits that insofar as the rejection of claims 2, 3, and 12 relies on the characterization of *Ono* advanced by the Examiner in connection with the rejection of claims 1 and 5-11 under 35 U.S.C. § 102(b), the rejection of claims 2, 3 and 12 lacks an adequate foundation, for at least the reasons outlined at II. above, and should accordingly be withdrawn.

Regarding claim 13, from which claims 14 and 16-18 depend, Applicant respectfully submits that, similar to the case of claims 1 and 8 discussed previously, the Examiner has failed to identify, with any specificity whatsoever, which element(s) of *Ono* is/are purported to correspond to the elements "an optical output," "a polarization state," and "a total polarization-dependent loss" recited in claim 13.

Finally, Applicant notes that it appears that the Examiner is relying on personal knowledge as a basis for rejecting claims 2, 3 and 12-14. Particularly, the Examiner has simply stated that "... adding a protective jacket or sheath to the fiber (and containing it within a petal) would have been obvious ... since protecting an optical fiber would inherently improve its optical coupling and decrease error/loss" (emphasis added), and the Examiner has not identified any references or other materials as being obvious to combine with the purported teachings of (the other cited reference(s)). In view of the foregoing, and pursuant to 37 C.F.R. 1.104(d)(2), Applicant hereby respectfully requests an Examiner affidavit that: (i) specifically identifies any and all reference(s), other than those that have been specifically cited by the Examiner, upon which the obviousness rejection of claims 2, 3 and 12-14 is based; and (ii) provides complete details concerning the reasoning and analysis of the Examiner concerning those references as those references are purported to apply to the rejection of claims 2, 3 and 12-14.

In view of the foregoing, Applicant respectfully submits that the Examiner has failed to establish a *prima facie* case of obviousness with respect to claims 2, 3, 12-14, and 16-18 at least because the Examiner has not established that the purportedly obvious combinations teach or suggest all the limitations of those claims. Applicant thus submits that the rejection of claims 2, 3, 12-14, and 16-18 should be withdrawn.

IV. Allowed Subject Matter

The Examiner has indicated that claims 4 and 15 would be allowable if rewritten to include all of the limitations of the base claim and any intervening claims. In view of the discussion set forth herein, Applicant respectfully declines to amend those claims at this time.

Applicant submits the following comments concerning the Examiner's statements of reasons for the indication of allowable subject matter in the Office Action. In general, Applicant agrees with the Examiner that the inventions to which claims 4 and 15 are respectively directed are patentable over the cited references, but respectfully disagrees with the Examiner's statement of reasons for allowance as set forth in the Office Action.

Particularly, Applicant submits that it is improper to characterize a single limitation, or subset of limitations, as constituting the basis for allowance of a claim. Rather, the patentability of a claim is properly determined with reference to the claim as a whole. Accordingly, Applicant does not concede that the reasons for allowable subject matter given by the Examiner are the only reasons that make, or would make, the claim allowable and Applicant does not make any admission or concession concerning the Examiner's statements in the Office Action concerning the allowability of claims 4 and 15 in view of the cited references.

CONCLUSION

In view of the remarks submitted herein, Applicant respectfully submits that each of the pending claims 1-18 is in condition for allowance. Therefore, reconsideration of the rejections is requested and allowance of those claims is respectfully solicited. In the event that the Examiner finds any remaining impediment to a prompt allowance of this application that could be clarified in a telephonic interview, the Examiner is respectfully requested to initiate the same with the undersigned attorney.

Dated this 28th day of April, 2006.

Respectfully submitted,



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